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ZOINLA (M) SDN BHD
v. ICARES TECHNOLOGY SDN BHD

HIGH COURT MALAYA, KUALA LUMPUR
AZLAN SULAIMAN JC
[CIVIL SUIT NO: WA-22IP-28-06-2023]
B 24 OCTOBER 2024

Abstract – *(i) In order to establish patent infringement, a claimant must prove that the alleged infringing product incorporates all the essential integers of the patent claim. The claims of the patent, not the abstract or preferred embodiments, are the primary reference point for determining infringement; (ii) Patent claims should be interpreted purposively, considering the overall intent and purpose of the invention; (iii) The testimonies of expert witnesses are vital in technical patent infringement cases to explain and elaborate on certain complex technical issues and assess whether there is indeed an infringement of a product.*

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INTELLECTUAL PROPERTY: *Patent – Utility innovation – Infringement – Smart community application for security management system – Application boasts certain specific features – Essential integers – Whether alleged infringer authorised or provided any licence to make, develop, use, sell, offer for sale, licence, advertise/promote for sale and/or make available app/system to public – Whether application/system comprised all essential integers – Whether there was infringement – Patents Act 1983*

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F In or around November 2018, the defendant launched a smart community mobile application ('app') known as 'ICARES' ('ICares'). ICares had been provided to numerous property developers, joint management bodies and corporations and resident associations across the country. The plaintiff alleged that ICares fell within the scope of the protection of Claim 1 of the 397 utility innovation ('UI'). Amongst others, (i) it related to a security management system which involved a server in communication over an internet network, with (a) a plurality of user mobile devices, each of which comprised an application interface with a panic button through which a panic alarm signal could be triggered; and (b) an alarm system provided with a display unit for alerting security guards upon receiving a panic alarm signal through the server from the user mobile device; (ii) the user mobile devices were also each provided with another application interface which allowed the user to input the visitor details; and (iii) the server could receive the visitor details from the user mobile devices and display the visitor details to the security guards on a display unit for verification upon scanning a visitor pass presented by the visitor. The plaintiff further alleged that it had never authorised or provided any licence to the defendant to make, develop, use, sell, offer for sale, licence, advertise/promote for sale and/or make available

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ICares to the public. Despite issuing a letter of demand to cease and desist any acts infringing the 397 UI, the defendant took the position that there was no infringement as ICares did not comprise all the essential integers of Claim 1 of the 397 UI. Hence, the present action by the plaintiff against the defendant for damages and other reliefs for the infringement of 397 UI. The parties agreed that the 397 UI had eight integers ('essential integers'), namely: (i) a security management system ('integer 1'); (ii) a server in communication with a plurality of user mobile devices ('integer 2'); (iii) a security point having an alarm system ('integer 3'); (iv) at least one display unit *via* a communication network ('integer 4'); (v) wherein the server included an alert module configured to transmit an instruction that sounded the alarm system upon receiving an alert signal from the user mobile devices ('integer 5'); (vi) wherein the server included a visitor module configured to transmit details of a visitor to the display unit for display upon receiving visitor details from the user mobile devices ('integer 6'); (vii) characterised in that the user mobile devices comprised an application to provide a first interface having a virtual button for transmitting the alert signal to the server ('integer 7'); and (viii) a second interface to allow a user to input the visitor details and to transmit the visitor details to the server ('integer 8'). The defendant did not dispute that ICares had integers 1, 2, 7 and 8. Consequently, the court's infringement analysis focused on integers 3, 4, 5 and 6.

Held (allowing reliefs sought by plaintiff as per para. [80] of the judgment):

(1) As the ICares app was a security management system, a security point was a necessity to monitor the ingress and egress into and out of the building or housing development using ICares. The purposive approach to the words 'alarm system' would envisage any system that emits signals, be it audible, visible or vibratory for the purpose of alerting security personal to a security breach or any safety hazardous situation. It was the claims of the patent/UI that mattered for determining the scope. Thus, the defendant's purported reliance on the abstract, the summary of the invention (including the preferred embodiments) and the figures/drawings was misconceived. In addition, the ICares app had a panic alarm features that was installed in both the users' and security guards' mobile devices that enabled the user to send out panic alarm signals to selected recipients, including the security guards. Therefore, this feature of the ICares app fell within the scope and meaning of an 'alarm system' under Claim 1 of 397 UI. (paras 43 & 49-52)

(2) There were two obvious components in integer 4, namely a display unit and a communication network. The court agreed and accepted the views of the plaintiff's expert witness ('Dr Koo'). Integer 4 of Claim 1 of 397 UI was present in the ICares app. (paras 53, 55 & 56)

(3) Dr Koo testified that he had personally tested the feature in integer 5 by installing the ICares Smart Community app on a mobile phone (acting as a user) and the ICares VCS app on a second other mobile phone (acting as an alarm system). After configuring the settings, Dr Koo found that the alarm in the iCares VCS app in the second other mobile phone would be sounded once he pressed the panic button in the iCares Smart Community app installed on the first mobile phone. Dr Koo concluded that integer 5 was present in the ICares app. Dr Koo was not challenged or cross-examined on any of this. On the contrary, the defendant's expert witness ('Dr Chee') admitted in cross examination in respect of the ICares app that when the user pressed the panic alarm button on the user device with the ICares app, the alarm signal would be sent to the server and subsequently transmitted to the security guard's mobile device installed with the ICares app, where the alarm would be sounded on the security guard's mobile device. Further, the defendant's CEO admitted in cross-examination that the user's mobile device and the security guard's mobile device, which were both installed with the ICares app, would interact with the server that was controlled by the defendant and the security guard's mobile device which was installed with the ICares app would have the panic alarm features as one of the recipients of the panic alarm triggered by the user. Based on these evidences, integer 5 of claim 1 of 397 UI was present in the ICares app. (paras 57-61)

(4) In his expert report, Dr Koo said that '… a visitor management module where user can input visitor details and send them to a server and the server can transmit the visitor details (such as name, phone number, NRIC and vehicle number) to other mobile devices where the information can be viewed using ICares VCS app … a display unit is not limited to a physical display unit, whereby the visitors' details or information could be viewed on the mobile device's screen.' Dr Koo concluded that integer 6 was present in the ICares app. Dr Chee admitted, in cross-examination, that the user's mobile device and the security guard's mobile device, which were both installed with the ICares app, would interact *via* the server controlled by the defendant. Based on these evidences, integer 6 of Claim 1 of 397 UI was present in the ICares app. (paras 62-64)

(5) As the ICares app infringed the 397 UI on the essential integers test, that would dispense with the need to invoke the *Actavis* test, as those tests presupposed the existence of variants in the ICares app not literally found within the 397 UI. (Editor's note: The court nevertheless, for the purpose of completeness, did consider whether the ICares app infringed the 397 UI using those tests. The court's analysis can be found in paras [69] to [79] of the judgment). (para 67)

Case(s) referred to:

Actavis UK Ltd And Others (Appellants) v. Eli Lilly And Company (Respondent) [2017] UKSC 48 ***(refd)***

Batu Kemas Industri Sdn Bhd v. Kerajaan Malaysia & Anor [2015] 7 CLJ 849 CA ***(refd)***

Cadware Sdn Bhd v. Ronic Corporation [2014] 9 CLJ 1 CA ***(refd)***

Electric & Musical Industries Ltd v. Lissen Ltd [1938] 4 All ER 221 ***(refd)***

Junaidi Abdullah v. PP [1993] 4 CLJ 201 SC ***(refd)***

Kingtime International Ltd & Anor v. Petrofac E&C Sdn Bhd [2018] CLJU 1658; [2018] 1 LNS 1658 HC ***(refd)***

PB Malaysia Sdn Bhd v. Samudra (M) Sdn Bhd [2008] CLJU 679; [2008] 1 LNS 679 HC ***(refd)***

Rodi & Wienenberger AG v. Henry Showell Ltd [1969] RPC 367 ***(refd)***

SKB Shutters Manufacturing Sdn Bhd v. Seng Kong Shutter Industries Sdn Bhd & Anor [2015] 9 CLJ 405 FC ***(refd)***

Spind Malaysia Sdn Bhd v. Justrade Marketing Sdn Bhd & Anor [2018] 4 CLJ 705 FC ***(refd)***

Syed Abu Bakar Ahmad v. PP [1984] 1 CLJ 80; [1984] 1 CLJ (Rep) 368 FC ***(refd)***

U Television Sdn Bhd & Anor v. Comintel Sdn Bhd [2017] 10 CLJ 580 FC ***(refd)***

Legislation referred to:

Evidence Act 1950, s. 45(1)

Patents Act 1983, ss. 17, 17A, 36(1), (2), (3), 58, 59

For the plaintiff - Su Siew Ling & Joyce Goh; M/s Linda Wang Su & Boo

For the defendant - Chung Chee Yien; M/s CY Chung & Assocs

Reported by Najib Tamby

JUDGMENT

Azlan Sulaiman JC:

Introduction

[1] This judgment is on the plaintiff's action for infringement of its registered utility innovation.

Preliminaries

The Patents Act 1983

[2] A utility innovation ("UI") has been described as a mini-patent. Indeed, there is no Utility Innovation Act and the primary legislation governing utility innovations is the Patents Act 1983 ("Act").

[3] Part IVA of the Act is entitled "Utility Innovations". Section 17 of the Act provides:

> Definition.
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> For the purposes of this Part and any regulations made under this Act in relation to this Part, "utility innovation" means any innovation which creates a new product or process, or any new improvement of a known product or process, which is capable of industrial application, and includes an invention.

[4] Section 17A of the Act provides:

> Application.
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> (1) Except as otherwise provided in this Part, the provisions of this Act, subject to the modifications in the Second Schedule, shall apply to utility innovations in the same manner as they apply to inventions.
>
> (2) Sections 11, 15, 26, Part X, and sections 89 and 90 shall not apply to utility innovations.

[5] Section 36 of the Act sets out the rights of a patent/utility innovation owner. Subsections (1), (2) and (3) provide:

> Section 36. Rights of owner of patent
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> (1) Subject and without prejudice to the other provisions of this Part, the owner of a patent shall have the following exclusive rights in relation to the patent:
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> (a) to exploit the patented invention;
>
> (b) to assign or transmit the patent;
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> (c) to conclude license contracts; and
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> (d) to deal with the patent as the subject of a security interest.
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> (2) No person shall do any of the acts referred to in subsection (1) without the consent of the owner of the patent.
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> (3) For the purpose of this Part, "exploitation" of a patented invention means any of the following acts in relation to a patent:
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> (a) when the patent has been granted in respect of a product:
>
> (i) making, importing, offering for sale, selling or using the product;
>
> (ii) stocking such product for the purpose of offering for sale, selling or using;
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> (b) when the patent has been granted in respect of a process:
>
> (i) using the process;
>
> (ii) doing any of the acts referred to in paragraph (a), in respect of a product obtained directly by means of the process.

[6] Section 58 of the Act provides for what constitutes infringement of a patent or UI.

> 58 Acts deemed to be infringement
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> Subject to subsection 37(1), (2) and (3) and section 38, an infringement of a patent shall consist of the performance of any act referred to in subsection 36(3) in Malaysia by a person other than the owner of the patent and without the agreement of the latter in relation to a product or a process falling within the scope of protection of the patent.

[7] The UI here, in simple terms, is in respect of an interactive security management system based on mobile devices. The plaintiff successfully registered it as Malaysian Utility Innovation No. MY-188397-A ("397 UI"); it was filed on 15 August 2016, published on 15 February 2018 and granted on 7 December 2021.

The Claims As The Scope Of Protection

[8] Even though the actual 397 UI document contains information on the registration particulars; details of prior art, the identities of the inventors and the owner; an abstract; the field of invention; background, summary; drawings and their brief descriptions of the drawings; and a detailed description, it is the claims of 397 UI that we would look to ascertain the scope of protection of 397 UI.

[9] In *Electric & Musical Industries Ltd v. Lissen Ltd* [1938] 4 All ER 221, Lord Atkin said:

> The function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers. Their primary object is to limit, and not to extend, the monopoly. What is not claimed is disclaimed. The claims must undoubtedly be read as part of the entire document, and not as a separate document. Nevertheless, the forbidden field must be found in the language of the claims, and not elsewhere.
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> It is not permissible, in my opinion, by reference to some language used in the earlier part of the specification to change a claim which by its own language is a claim for one subject-matter into a claim for another and a different subject-matter, which is what you do when you alter the boundaries of the forbidden territory. A patentee who describes an invention in the body of a specification obtains no monopoly unless it is claimed in the claims. As Lord Cairns LC said, there is no such thing as infringement of the equity of a patent: *Dudgeon v. Thomson*.

[10] Wong Kian Kheong J (now JCA) approved of that passage in *Electric & Musical Industries*, in *Kingtime International Ltd & Anor v. Petrofac E&C Sdn Bhd* [2018] CLJU 1658; [2018] 1 LNS 1658; [2018] MLJU 1840. He said:

> the monopoly of an invention as conferred by a patent is defined only in the Claims [not the Abstract, Descriptions, Drawings and other specifications of the patent (Other Patent Specifications)] - please see reg. 13(5) PR and Lord Russell's judgment in the House of Lords in *Electric & Musical Industries Ltd & Ors v. G Kalis* [1939] RPC 23, at 39.

[11] 397 UI has only one claim, which is:

> A security management system comprising:
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> a server (2) in communication with a plurality of user mobile devices (3) and a security point (1) having an alarm system (11) and at least one display unit *via* a communication network;

wherein the server (2) includes an alert module configured to transmit an instruction that sounds the alarm system (11) upon receiving an alert signal from the user mobile devices (3);

wherein the server (2) includes a visitor module configured to transmit details of a visitor to the display unit for display upon receiving visitor details from the user mobile devices (3);

characterized in that the user mobile devices (3) comprises an application to provide a first interface having a virtual button for transmitting the alert signal to the server (2), and a second interface to allow a user to input the visitor details and to transmit the visitor details to the server (2).

The Tests For Patent/UI Infringement

[12] In *Rodi & Wienenberger AG v. Henry Showell Ltd* [1969] RPC 367, Lord Upjohn said:

> To constitute infringement, the article must take each and every one of the essential integers of the claim. Non-essential integers may be omitted or replaced by mechanical equivalents.

[13] In *Cadware Sdn Bhd v. Ronic Corporation* [2014] 9 CLJ 1; [2013] 6 MLJ 19, Mohd Hishamudin JCA said:

> We hold that in determining patent infringement, it is the doctrine of purposive construction that ought to be applicable. In the landmark case of *Catnic Components Ltd & Anor v. Hill & Smith Ltd* [1982] RPC 183, the House of Lords discarded the pith and marrow test and formulated a new doctrine: the doctrine of purposive construction. In this case, Lord Diplock said (at pp. 242-243):
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> > A patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too oftentempted by their training to indulge. The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked.
> >
> > The question, of course, does not arise where the variant would in fact have a material effect upon the way the invention worked. Nor does it arise unless at the date of publication of the specification it would be obvious to the informed reader that this was so. Where it is not so obvious, in the light of then-existing knowledge, the reader is entitled to assume that the patentee thought at the time of the specification that he had good reason for limiting his monopoly so strictly and had intended to do so, even though subsequent work by him or others in the field of the

> invention might show the limitation to have been unnecessary. It is to be answered in the negative only when it would be apparent to any reader skilled in the art that a particular descriptive word or phrase used in a claim cannot have been intended by a patentee, who was also skilled in the art, to exclude minor variants which, to the knowledge of both him and the readers to whom the patent was addressed, could have no material effect upon the way in which the invention worked.

We shall refer to the above question as the '*Catnic* question. In *Improver Corpn v. Remington Consumer Products Ltd* [1990] FSR 181, Hoffmann J reformulated the one *Catni*c question into the following three-stage test known as the *Improver* questions'. The *Improver* questions are as follows (at pp 188-189):

> The proper approach to the interpretation of patents registered under the Patents Act 1949 was explained by Lord Diplock in *Catnic Components Ltd v. Hill & Smith Ltd*. The language should be given a 'purposive' and not necessarily a literal construction. If the issue was whether a feature embodied in an alleged infringement which fell outside the primary, literal or contextual meaning of a descriptive word or phrase in the claim ('a variant') was nevertheless within its language as properly interpreted, the court should ask itself the following three questions:
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> (a) Does the variant have a material effect on the way the invention works? If yes, there is no infringement. If no;
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> (b) Would the immaterial variant have been obvious at the date of publication of the patent to a reader skilled in the art? If no, there is no infringement. If yes;
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> (c) Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? If yes, there is no infringement. If no, infringement will be established.

[14] *Actavis UK Ltd And Others (Appellants) v. Eli Lilly And Company (Respondent)* [2017] UKSC 48, the UK Supreme Court reformulated what Mohd Hishamudin JCA referred to in *Cadware* as 'the *Catnic* question' and 'the *Improver* questions'. In para. 66 of the judgment, Lord Neuberger set out the three reformulated questions – now commonly referred to as 'the *Actavis* questions' – as follows:

> (i) Notwithstanding that it was not within the literal meaning of the relevant claim(s) of the patent, did the variant achieve substantially the same result in substantially the same way as the invention, *ie*, the inventive concept revealed by the patent?
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> (ii) Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieved substantially the same result as the invention, that it did so in substantially the same way as the invention?

(iii) Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?

In order to establish infringement in a case where there was no literal infringement, a patentee would have to establish that the answer to the first two questions was 'yes' and that the answer to the third question was 'no'.

[15] In further elaboration of the need for purposive construction of the claims, in *Spind Malaysia Sdn Bhd v. Justrade Marketing Sdn Bhd & Anor* [2018] 4 CLJ 705, Raus Sharif CJ said:

A purposive construction is to be adopted to give effect to what the person skilled in the art would have understood the patentee to be claiming (*Catnic Components Ltd and Another v. Hill And Smith Ltd* [1982] RPC 183 at 235-236).

The threshold question is: what would the person skilled in the art have understood the patentee to be using the language of the claim to mean? As eloquently explained by Lord Hoffmann in *Kirin-Amgen Inc and others v. Hoechst Marion Roussel Ltd And Others* [2004] UKHL 46 at [34]:

> 'Purposive construction' does not mean that one is extending or going beyond the definition of the technical matter for which the patentee seeks protection in the claims. The question is always what the person skilled in the art would have understood the patentee to be using the language of the claim to mean. And for this purpose, the language he has chosen is usually of critical importance. The conventions of word meaning and syntax enable us to express our meanings with great accuracy and subtlety and the skilled man will ordinarily assume that the patentee has chosen his language accordingly. As a number of judges have pointed out, the specification is a unilateral document in words of the patentee's own choosing. Furthermore, the words will usually have been chosen upon skilled advice. The specification is not a document *inter rusticos* for which broad allowances must be made ... There will be occasions upon which it will be obvious to the skilled man that the patentee must in some respect have departed from conventional use of language or included in his description of the invention some element which he did not mean to be essential. But one would not expect that to happen very often.

Thus the language used by the patentee is more often than not of utmost importance (*First Currency Choice* at [27]). While the claim may be construed in the context of the specification as a whole, it is not permissible to alter the scope of the claims beyond its language by reference to the language used in the earlier part of the specification (*Electric & Musical Industries* at 39).

The POSITA

[16] To navigate through the labyrinth of the claims and determining the issue of infringement or even invalidation of a patent or utility innovation without ever delegating the decision-making, the court is ordinarily assisted by experts, commonly referred to as persons ordinarily skilled in the art, acronym, 'POSITA'. The parties to the action ordinarily appoint their own respective POSITA who prepare and adduce their reports on infringement and/or invalidation as the case may be. If need be, the court is also at liberty to appoint its own court-appointed POSITA.

[17] The role of the POSITA is to assist the court, by providing their expert opinion in their specialist area related to the subject matter of the patent/UI. Section 45(1) of the Evidence Act 1950 provides:

> When the court has to form an opinion upon a point of foreign law or of science or art, or as to identity or genuineness of handwriting or finger impressions, the opinions upon that point of persons specially skilled in that foreign law, science or art, or in questions as to identity or genuineness of handwriting or finger impressions, are relevant facts.

[18] In *Syed Abu Bakar Ahmad v. PP* [1984] 1 CLJ 80; [1984] 1 CLJ (Rep) 368; [1984] 2 MLJ 19, Abdul Hamid FCJ (as he then was) said:

> Our law is clear in that under s. 45 of our Evidence Act 1950 it is provided that ... The scope of this section can be found in the commentary in *Sarkar on Evidence* (12th Ed) at p. 488 where, while recognising that opinion in so far as it may be founded on legal evidence shall be the function of the tribunal whose province alone it is to draw conclusions of law or fact:
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> > There are however cases in which the court is not in a position to form a correct judgment without help of persons who have acquired special skill or experience on a particular subject, *eg*, when the question involved is beyond the range of common experience or common knowledge or when special study of a subject or special training or special experience therein is necessary. In such cases the help of experts is required. In these cases, the rule is relaxed and expert evidence is admitted to enable the court to come to a proper decision.

[19] In *PB Malaysia Sdn Bhd v. Samudra (M) Sdn Bhd* [2008] CLJU 679; [2008] 1 LNS 679; [2009] 7 MLJ 681, Ramly Ali J (as he then was) said:

> Opinions of experts are admissible to furnish the court with scientific information which is unlikely to be within the experience and knowledge of a judge (s. 451(1) of the Evidence Act 1950).

[20] In respect of experts in patent or utility innovation infringement actions, in *SKB Shutters Manufacturing Sdn Bhd v. Seng Kong Shutter Industries Sdn Bhd & Anor* [2015] 9 CLJ 405; [2015] 6 MLJ 293, Zulkefli CJ (Malaya) said:

A On the said questions (5) and (6) posed by the appellant we are of the view the general principles relating to the construction of patent claims and the role to be played by the 'experts' are well-established. The function of the expert is to educate the court in technology and that they come as teachers, as makers of the mantle for the court to don. For that purpose, it does not matter if they do not approximate a person skilled B in the art (see the case of *Technip France SA's Patent*). As such, clearly the court can construe patent claims without the assistance of a person skilled in the art. Any assistance required is from an expert and he need not approximate a skilled person.

[21] In *Batu Kemas Industri Sdn Bhd v. Kerajaan Malaysia & Anor* [2015] C 7 CLJ 849, Vernon Ong JCA (as he then was) said:

(1) Expert evidence presented to the court should be, and should be seen to be, the independent product of the expert uninfluenced as to form or to content by the exigencies of litigation (*Whitehouse v. Jordan* [1981] 1 WLR 246 at 256-257; 1 All ER 267 at 276 per Lord Wilberforce.

D (2) An expert witness should provide independent assistance to the court by way of objective unbiased opinion in relation to matters within his expertise (see *Polivitte Ltd v. Commercial Union Assurance Co Plc* [1987] 1 Lloyd's Rep 379 at 386 per *Garland J and Re J* [1991] FCR 193 per Cazalet J). An expert witness in the High Court should never assume the E role of an advocate.

(3) An expert witness should state the facts or assumptions upon which his conclusions are based. He should not omit to consider material facts which could detract from his concluded opinion (*Re J*).

(4) An expert witness should make it clear when a particular question or F issue falls outside his expertise.

(5) If an expert's opinion is not properly researched because he considers that insufficient data is available, then this must be stated with an indication that the opinion is no more than a provisional one (*Re J*). In cases where an expert witness who has prepared a report could not assert that the report contained the truth, the whole truth and nothing but the G truth without some qualification, the qualification should be stated in the report (*Derby & Co Ltd v. Weldon* (1990) Times, 9 November per Staughton LJ).

(6) If, after exchange of reports, an expert witness changes his view on a material matter having read the other side's expert's report or for any H other reason, such change of view should be communicated (through legal representatives) to the other side without delay and where appropriate to the court.

[22] The Federal Court, in *U Television Sdn Bhd & Anor v. Comintel Sdn Bhd* [2017] 10 CLJ 580; [2017] 5 MLJ 292, approved of this statement in *Batu* I *Kemas*, (*supra*).

[23] In *Junaidi Abdullah v. PP* [1993] 4 CLJ 201; *U Television Sdn Bhd & Anor v. Comintel Sdn Bhd* [2017] 10 CLJ 580; [2017] 5 MLJ 292 at 309; [1993] 3 MLJ 217, Mohamed Azmi SCJ said: A

> In our view, the test to be applied for the purpose of s. 45 of the Evidence Act 1950 is this. First, does the nature of the evidence require special skill?
>
> Second, if so, has the witness acquired the necessary skill either by academic qualification or experience so that he has adequate knowledge to express an opinion on the matter under enquiry? The answer to both questions must necessarily depend on the facts of each particular case. The specialty of the skill required of an expert witness under s. 45 would depend on the scientific nature and complexity of the evidence sought to be proved. The more scientific and complex the subject matter, the more extensive and deeper will the court be required to enquire into the ascertainment of his qualification or experience in the particular field of art trade or profession.

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[24] The principles to be distilled from these cases include the following: D

(i) whenever the question before the court is beyond the range of common experience or common knowledge or when special study of a subject or special training or special experience therein is necessary, and the court is not in a position to form a correct judgment without the help of persons who have acquired that special skill or experience on a particular subject, then experts are called and expert evidence is admitted to enable the court to come to a proper decision; E

(ii) conversely, whenever the question before the court is not beyond the range of common experience or common knowledge but merely requires a simple construction of the common words used, then the court does not need the opinion of experts; F

(iii) for the construction of patents, the function of the expert is to educate the court in technology and that they come as teachers, as makers of the mantle for the court to don;

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(iv) notwithstanding the views of the experts, at the end of the day, it is the court that decides, and the court may even dispense with the need for the opinions of the experts.

[25] I hold that the POSITA's expert(s) view here is important for the following matters: H

(i) the construction of 397 UI patent, especially claim 1; and

(ii) whether claim has been infringed by ICares under s. 59 read with s. 36 of the Act.

[26] The plaintiff called upon Dr Koo Voon Chet ("Dr Koo") as its expert, whereas the defendant called upon Dr Chee Jenn Yang ("Dr Chee"). Both produced their expert reports and a further report to rebut the other's. I

[27] Apart from challenging the findings, opinions and conclusions of the other side's expert, it is also common for parties to challenge their credibility as experts so as to exclude their opinion altogether. The attack on their credibility can include their qualifications as an expert. That was the case here, by the plaintiff against Dr Chee, and thus on his patent infringement analysis report dated 7 July 2023 ("Dr Chee's expert report").

[28] I find that Dr Chee is not an expert or POSITA in this case and I therefore find that I cannot rely on the findings, opinions and conclusions in Dr Chee's expert report, on two scores.

[29] First, he does not have the necessary qualifications to be regarded as an expert in this case. His Bachelor's Degree is in Plant Biology (2011) and he was conferred with a PhD in Biosciences (2017). In 2021, he was conferred a Masters of Law in Science Law. In 2017, he started employment with NBS Intellectual Property Services that offers services in the area of registration of trademarks, patents, copyrights and industrial designs, and has worked his way up from patent executive to patent manager. Dr Chee testified that his experience as a patent agent is what makes him an expert for this case.

[30] I do not agree. Experience – even years of substantial experience – as a patent agent does not make one an expert in this case. It might make him an expert in the field of registration of trademarks, patents, copyrights and industrial designs, but does not make him an expert in the issues in this case, namely whether ICares infringes 397 UI. Having the qualification and experience as a patent agent alone does not make him an expert here, because the issue here is not about the science of the registration of 397 UI.

[31] The second is that he does not have the necessary independence required and expected of an expert. During the trial, Dr Chee testified that Dr Chee's expert report was prepared by him and his team. In my view, that is not good enough. Whilst an expert can receive the assistance of a back-up staff of researchers, *etc,* ultimately, any report that he or she comes up with must be his own handiwork.

[32] On the other hand, I find that Dr Koo can be accepted as an expert witness. In August 1997, he was conferred with a Bachelor's Degree (Honours Class 1) in Electrical Engineering from the University of Malaya, in November 1999 and December 2005 obtained a Masters of Engineering Science and a PhD, respectively, from Multimedia University. His areas of expertise include synthetic aperture radar, radar signal processing, microwave remote sensing, and smart sensing and analytics. Those are relevant to the construction of claim 1 and the issue of whether claim has been infringed by ICares.

The Defendant's Alleged Infringement

[33] In or around November 2018, the defendant launched a smart community mobile application named "ICARES" ("ICares"). The defendant advertises ICares online on its website https://www.icares.app/ and also makes it available for download by the defendant *via* the Google Play Store and the Apple App Store. The defendant has also promoted ICares on social media such as LinkedIn, Facebook and YouTube. As of the date of filing of this action, the defendant's LinkedIn, Facebook and YouTube accounts on ICares had approximately 1,157 followers, 353 likes and 1,000 views, respectively. As a result, ICares has been provided to numerous property developers, joint management bodies, joint management corporations and resident associations across the country.

[34] The plaintiff alleges that ICares falls within the scope of the protection of claim 1 of the 397 UI in that it comprises all of the essential integers of claim 1 of the 397 UI. Amongst others:

(i) it relates to a security management system;

(ii) the security management system involves a server in communication, over an internet network, with:

(a) a plurality of user's mobile devices, each of which comprises an application interface with a panic button through which a panic alarm signal can be triggered; and

(b) an alarm system provided with a display unit for alerting security guards upon receiving a panic alarm signal through the server from the user's mobile device;

(iii) the user's mobile devices are also each provided with another application interface which allows the user to input the visitor details; and

(iv) the server can receive the visitor details from the user's mobile devices and display the visitor details to the security guards on a display unit for verification upon scanning a visitor pass presented by the visitor.

[35] The plaintiff further alleges that it has never authorised or provided any license to the defendant to make, develop, use, sell, offer for sale, license, advertise/promote for sale and/or make available ICares to the public, whether by itself or through its agents and/or customers.

[36] Despite its solicitors issuing a letter of demand on 10 May 2023 to cease and desist any acts infringing the 397 UI, the defendant has taken the position that there is no infringement as ICares does not comprises all the essential integers of claim 1 of the 397 UI.

[37] The plaintiff filed this action on 6 June 2023 for damages and other relief for infringement of 397 UI. The defendant is maintaining that ICares does not infringe 397 UI, and seeks a dismissal of the action with costs.

[38] With no counterclaim to invalidate 397 UI, the only issue to be decided is whether ICares infringes 397 UI.

Whether ICares Infringes 397 UI

Essential Integers Test

The Integers Of 397 UI

[39] The parties agree that the 397 UI has eight integers (collectively, "essential integers"), namely:

1. a security management system comprising;
2. a server in communication with a plurality of user's mobile devices;
3. a security point having an alarm system;
4. at least one display unit *via* a communication network;
5. wherein the server includes an alert module configured to transmit an instruction that sounds the alarm system upon receiving an alert signal from the user's mobile devices;
6. wherein the server includes a visitor module configured to transmit details of a visitor to the display unit for display upon receiving visitor details from the user's mobile devices;
7. characterised in that the user mobile devices comprises an application to provide a first interface having a virtual button for transmitting the alert signal to the server; and
8. a second interface to allow a user to input the visitor details and to transmit the visitor details to the server.

[40] The defendant does not dispute that ICares has integers (1), (2), (7) and 8. Consequently, the infringement analysis will be focused on integers (3), (4), (5) and (6).

Integer (3): A Security Point Having An Alarm System

[41] There are two obvious components to integer (3), namely a security point and an alarm system.

[42] Tan Hai Fong (PW2), a property agent attached to Worldmart Properties in Johor Bahru, had visited a residential project in Johor Bahru named D'Grande Residences, one of the venues that deployed ICares. Snapshots of a video PW2 took show a physical security point at D'Grande Residences. A physical security point with a boom gate is also clearly visible on the snapshot of the defendant's YouTube video of the ICares app.

[43] I agree with the plaintiff's contention that, as the ICares app is a security management system, a security point is a necessity to monitor the ingress and egress into and out of the building or housing development using ICares.

[44] I reject the defendant's contention that the depiction of the security point on the defendant's YouTube video of the ICares app is for marketing and advertising purposes and nothing more. That evidence was not substantiated, and if the defendant is admitting to false advertising, then this court will not favour it.

[45] In respect of integer (3), it is with the second component that the defendant takes a more forceful defence. The defendant contends that, based on the abstract (57) in 397 UI, the summary of the invention (including some of the preferred embodiments), and figures 2-5 drawings, the alarm system must be and can only be physical, whereas the alarm function on the guard's mobile device and the display on the guard's mobile device is not and cannot logically and possibly be a physical alarm.

[46] The plaintiff, on the other hand, contends that there is nothing in claim 1 which restricts the alarm system to a physical alarm device or an alarm system that is installed separately at the security point.

[47] The plaintiff further contends that the term "alarm system" under claim 1 covers any system that is capable of emitting signals (either audible or visible, including vibration signals) that would allow security guards to be alerted on the occurrence of a security-breaching event.

[48] Dr Koo expressed the same in his expert report at para. 15.2(a) of his expert report. He said:

> Art alarm system is a system that will emit signals (either audible or visible, including vibration signals) to alert users during the occurrence of an undesirable event. An alarm system is not confined to a physical system installed at a security point. It could be a mobile device that has an alarm function. As long as there is a means to alert security guards, the element of an alarm system is present.

[49] I agree. In my view, the purposive approach to word "alarm system" would envisage any system that emits signals, be it audible, visible, or vibratory for the purpose of alerting security personnel to a security breach or any safety-hazardous situation.

[50] Further, as I had already pointed out, it is the claims of the patent/utility innovation that matter for determining its scope. Thus, the defendant's purported reliance on the abstract, the summary of the invention (including preferred embodiments), and the figures/drawings is misconceived.

[51] In addition, the ICares App has a panic alarm feature that is installed in both the users' and security guards' mobile devices that enables the user to send out panic alarm signals to selected recipients including the security guards.

[52] I accordingly find that this feature of the ICares App falls within the scope and meaning of an "alarm system" under claim 1 of 397 UI.

Integer (4): At Least One Display Unit *Via* A Communication Network

[53] There are two obvious components to integer (4), namely a display unit and a communication network.

[54] The defendant again contends that based on the abstract (57), the summary of the invention (including some of the preferred embodiments), and the drawings that the display unit must also be physical.

[55] In para. 15.2(b) of his expert report, Dr Koo said:

> A display unit is a device with a screen that displays characters and graphics representing data in a computer memory. A display unit is not limited to a display monitor. Any device that consists of a display function (such as a smart tv, computer monitor, mobile phone display or tablet display screen) can be considered as a "display unit".
>
> A communication network is a system or infrastructure that enables the exchange of information, data, or messages between multiple devices, users, or entities. These networks can be wired (*eg*, ethernet, LAN) or wireless (*eg*, WiFi, cellular networks).
>
> A "display unit *via* a communication network" may include a mobile device such as a mobile phone or tablet that has a display function and a means to exchange information *via* network. Integer 4 is not restricted to the use of a physical display monitor.
>
> It is obvious that the ICares App utilizes a mobile device with a display unit to display and exchange information *via* a communication network.
>
> In conclusion, Integer 4 is present in ICares app.

[56] I agree with and accept these views, and accordingly find that integer (4) of claim 1 of 397 UI is present in the ICares app.

Integer (5): Wherein The Server Includes An Alert Module Configured To Transmit An Instruction That Sounds The Alarm System Upon Receiving An Alert Signal From The User's Mobile Devices

[57] In para. 15(c) of his expert report, Dr Koo testified that he had personally tested this feature by installing the ICares Smart Community App on a mobile phone (acting as a user) and the ICares VCS App in a second other mobile phone (acting as an alarm system). After configuring the

settings, he found that the alarm in the ICares VCS App in the second other mobile phone would be sounded once he had pressed the panic button in the ICares Smart Community App installed on the first mobile phone. He then said:

> Based on my analysis, this can only happen when the first mobile phone sends an alert signal from the iCares Smart Community App (the first mobile device) to the server. Upon receiving the alert signal, the server transmits an instruction to the iCares VCS App (the second mobile device) to sound the alarm.
>
> In conclusion, Integer 5 is present in ICares app.

[58] Dr Koo was not challenged or cross-examined on any of this.

[59] To the contrary, Dr Chee (DW1) admitted in cross-examination in respect of the ICares App that when the user presses the panic alarm button on the user device, with the ICares app, the alarm signal will be sent to the server and subsequently transmitted to the security guard's mobile device installed with the ICares app, whereupon the alarm will be sounded on the security guard's mobile device.

[60] Further, Kang Kim Lun, the defendant's CEO (DW2), admitted in cross-examination that the user's mobile device and the security guard's mobile device which are both installed with the ICares app will interact with the server that is controlled by the defendant, and that the security guard's mobile device which is installed with the ICares app will have the panic alarm feature as one of the recipients of the panic alarm triggered by the user.

[61] Based on these evidences, I accordingly find that integer (5) of claim 1 of 397 UI is present in the ICares app.

Integer (6): Wherein The Server Includes A Visitor Module Configured To Transmit Details Of A Visitor To The Display Unit For Display Upon Receiving Visitor Details From The User's Mobile Devices

[62] In para. 15.2(d) of his expert report, Dr Koo said:

> The ICares app has a visitor management module where user can input visitor details and send them to a server, and the server can transmit the visitor details (such as name, phone number, NRIC and vehicle number) to other mobile devices where the information can be viewed using iCares VCS App (refer to Annexure B, Figure B.8, Figure B. 9 and Figure B. 10)
>
> As explained in paragraph 15(b) above, a display unit is not limited to a physical display unit, whereby the visitors details or information can be viewed on the mobile device's screen.
>
> In conclusion, Integer 6 is present in ICares app.

[63] As I mentioned earlier, DW2 had admitted in cross-examination that the user's mobile device and the security guard's mobile device which are both installed with the ICares app will interact *via* the server controlled by the defendant.

[64] Based on these evidences, I accordingly find that integer (6) of claim 1 of 397 UI is present in the ICares app.

[65] In para. 17 of his expert report, Dr Koo concluded:

> For the reasons set forth in my analysis, all the 8 essential integers of the 397 UI are found to be present in the ICares app.

[66] As I have also found that all of the essential integers are present in the iCares app, I find that the ICares app infringes the 397 UI.

The Improver/Actavis Test

[67] As I have already found that the ICares app infringes the 397 UI on the essential integers test, that would dispense with the need to invoke the *Actavis* test, as those tests presuppose the existence of variants in the ICares app not literally found within the 397 UI.

[68] Nevertheless, for the purpose of completeness, I will still consider whether the ICares app infringes the 397 UI using those tests.

[69] Here, invoking those tests would mean considering:

(i) whether the use of a virtual alarm instead of a physical alarm installed at the security point; and/or

(ii) whether the use of a screen of mobile device (such as the screen of a mobile device, such as a mobile phone or tablet installed with the defendant's ICares app as a display unit) instead of a computer monitor are material variants to the invention in the 397 UI in that they will have a material effect on the way the invention in the 397 UI works.

[70] In my opinion, the function and purpose of an alarm system remain the same, whether the alarm is triggered on the security guard's mobile phone or through an external alarm device.

[71] I also find that the panic alarm feature in the ICares app achieves the same function and purpose as the alert module feature in the 397 UI. The ICares app allows the user to press the virtual panic alarm button on the user's mobile device installed with the ICares app when a security situation arises, and an alarm signal would be sent to the server and subsequently transmitted to the security guard's mobile device installed with the ICares app, to sound the alarm on the security guard's mobile device. That is essentially the same function and purpose as the alert module feature in the claim of the 397 UI.

[72] Thus, whether the alarm system takes the form of virtual alarm installed in the mobile device or a physical alarm system that is fixed at the security point, the invention under the claim of the 397 UI is still being deployed, namely the user triggering the panic alarm from a mobile device, the alarm signal being sent to the server, and the alarm subsequently transmitted to the recipient to sound the alarm system to alert the recipient.

[73] Likewise, in my opinion, the function and purpose of a display unit remain the same, whether the information is displayed on the security guard's mobile phone or on a computer monitor.

[74] Irrespective of whether a physical computer monitor or a display screen of the security guard's mobile device is used, the visitor information will still be displayed on a screen, which is the whole purpose of having a display unit under the 397 UI. In this respect, I find there to be no material difference between the display of the same visitor information either on the display screen of a mobile device, or on a computer monitor. In other words, the invention under 397 UI still works substantially the same way and to achieve substantially the same result regardless of whether a computer monitor or a display screen of the mobile device is used by the security guard. The display unit can be either or both.

[75] The evidence further shows that the ICares app has a visitor module by which the resident user can input expected visitor details and information (such as name, visiting date and time, contact number) that will be sent to the server, and from there, the server can transmit those same details to other mobile devices (including the security guard's mobile device), with such information displayed on that mobile device. I find that this process has no material difference from integer (4) of the claim of 397 UI:

> wherein the server (2) includes a visitor module configured to transmit details of a visitor to the display unit for display upon receiving visitor details from the user mobile devices (3).

[76] To round up, I also find that the use of a mobile device incorporating a virtual alarm (instead of a physical alarm) and the screen of that same mobile device being a display unit (instead of a computer monitor) is obvious to a POSITA.

[77] In tandem with that, I also find that it would also have been obvious to a POSITA that the use of a virtual alarm (instead of a physical alarm) and the screen of that same mobile device being a display unit (instead of a computer monitor) would not have a material effect on and will still achieve substantially the same result in substantially the same way as the invention in 397 UI. PW3 confirmed this in his expert report, which evidence I accept and agree with.

[78] Consequently, I find that, even if the differences between the ICares app and 397 UI are variants, applying the *Actavis* questions, I would find as follows:

(i) notwithstanding that they were not within the literal meaning of claim 1 of 397 UI, the variants achieved substantially the same result in substantially the same way as the invention, *ie*, the inventive concept revealed by 397 UI;

(ii) it would be obvious to the POSITA reading 397 UI at the priority date, but knowing that the variant achieved substantially the same result as the invention, that it did so in substantially the same way as the invention; and

(iii) a reader of 397 UI would not have concluded that the owner of 397 UI nonetheless intended that strict compliance with the literal meaning of claim 1 of 397 UI was an essential requirement of the invention.

[79] Thus, even if the improver test or the questions were to apply, I would find that the ICares app infringes the 397 UI.

Orders/Relief

[80] Having found that the ICares app infringes the 397 UI, I turn now to the relief sought by the plaintiff in its amended statement of claim, and allow the following:

(i) a declaration that the defendant has infringed the Malaysian Utility Innovation No. MY-188397-A;

(ii) a permanent injunction to restrain the defendant, whether acting by itself or through its directors, officers, employees, servants and/or agents or any of them or otherwise howsoever, from:

(a) infringing Utility Innovation No MY-188397-A including but not limited to creating, developing, using, offering for sale, advertising and/or promoting for sale, selling, licensing, making available to the public and/or howsoever dealing with, in any form whatsoever, any smart community mobile application which exploits the claimed features of the said utility innovation ("infringing smart community application"); and

(b) authorising, permitting, assisting, causing and/or enabling others to commit any of the acts of infringements set out in para. (ii)(a) above;

(iii) an order for full discovery against the defendant (which the defendant shall comply within on or before 15 November 2024 of all relevant documents and information relating to the infringing smart community application, including but not limited to the number and details of projects, correspondences, contracts, customer records, financial

records, price quotes, receipts and other documents as may be requested by the plaintiff that are in the possession, custody or control of the defendant, its officers, employees, servants and/or agents;

(iv) an order for the defendant to remove and/or destroy all articles, marketing materials, information leaflets, literature, brochures, advertisements, digital and/or printed materials and any other materials which were published and/or made available by the defendant to the public in whatsoever form or manner relating to the infringing smart community application, including but not limited to the defendant's website and social media platform and to affirm, file in court and serve on the plaintiff's solicitors an affidavit stating compliance with the same on or before 15 November 2024;

(v) an inquiry as to damages, or at the plaintiff's option, an account of profits made by the defendant in respect of the infringing smart community application and for payment by the defendant to the plaintiff of all sums found due upon the making of such inquiry or taking of such account;

(vi) interest at the rate of 5% per annum on all sums, whether on damages as assessed and/or on an account of profits, from the date of this judgment until full settlement.

[81] During oral submissions, counsel for the defendant informed the court that the defendant would be seeking costs of RM200,000 if this action were dismissed. In its written submissions, the plaintiff asked for a sum just north of RM180,000.

[82] The variant is immaterial (no pun intended). The work done by either side on this case would have been substantially the same. Thus, I will take the plaintiff's RM200,000 as the costs.

[83] My further reasoning for that is that, if the 'losing' party believes that it should have received a certain amount of costs had it won, then the 'winning' party should get that costs too. The defendant surely cannot baulk at that and expect for its costs and that of the plaintiff to be different. The idiom of equating what is good for a goose and a gander comes to mind.